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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,481	04/15/2004	Vincent Ling	WYS-00501	7025

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EXAMINER

OUSPENSKI, ILIA I

ART UNIT PAPER NUMBER

1644

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,481

Applicant(s)

LING ET AL.

Examiner

ILIA OUSPENSKI

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1 – 21 are pending.

2. The following inconsistencies and apparent errors are noted in the claims: claim 3 is dependent on claim 3; claim 12 reciting "antagonist" when apparently "agonist" was intended; and a spelling error in 9 ("from" rather than "form").

For examination purposes, it is assumed that claim 3 depends on claim 2, and that claim 12 recites "agonist." Applicant is invited to provide clarification, and to proofread the claims and correct any other errors.

Restriction Requirement

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1 – 11 and 17 – 21, drawn to a method of inhibiting activation of a lymphocyte, comprising contacting the lymphocyte with a B7-H3 agonist, wherein the agonist is a soluble form of B7-H3, classified in Class 514, subclass 12.

II. Claims 1, 12, and 17 – 21, drawn to a method of inhibiting activation of a lymphocyte, comprising contacting the lymphocyte with a B7-H3 agonist, wherein the agonist is a nucleic acid encoding a polypeptide of amino acid of SEQ ID NO:15, classified in Class 514, subclass 44.

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III. Claims 13 – 15 and 17 – 21, drawn to a method of enhancing activation of a lymphocyte, comprising contacting the lymphocyte with a B7-H3 antagonist, wherein the antagonist is an antibody to B7-H3, classified in Class 424, subclass 130.1.

IV. Claims 13 – 15 and 17 – 21, drawn to a method of enhancing activation of a lymphocyte, comprising contacting the lymphocyte with a B7-H3 antagonist, wherein the antagonist is an antibody against a B7-H3 receptor, classified in Class 424, subclass 130.1.

V. Claims 13 – 14, 16, and 17 – 21, drawn to a method of enhancing activation of a lymphocyte, comprising contacting the lymphocyte with a B7-H3 antagonist, wherein the antagonist is an antisense nucleic acid, classified in Class 514, subclass 44.

VI. Claims 13 – 14, 16, and 17 – 21, drawn to a method of enhancing activation of a lymphocyte, comprising contacting the lymphocyte with a B7-H3 antagonist, wherein the antagonist is a siRNA, classified in Class 514, subclass 44.

4. Groups I – VI are different methods. The methods differ with respect to one or more of ingredients, method steps, and/or endpoints; therefore, each method is patentably distinct. Furthermore, the distinct ingredients, method steps, and/or endpoints require separate and distinct searches. As such, it would be burdensome to search these Inventions together.

5. These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. Further, even though in some cases the classification is shared, a different field of search would be required based upon the

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structurally distinct products recited and the various methods of use comprising distinct method steps. Moreover, a prior art search also requires a literature search. It is an undue burden for the examiner to search more than one invention. Therefore restriction for examination purposes as indicated is proper.

Species Election

6. This application contains claims directed to the following patentably distinct species of the claimed Invention I: wherein the soluble form of B7-H3 comprises one of: SEQ ID NO:16, 17, 18, 19, 20, 21, or 22.

These species are distinct because their structures, physicochemical properties and mode of action are different, and they do not share a common structure that is disclosed to be essential for common utility. Furthermore, the examination of these species would require different searches in the scientific literature. As such, it would be burdensome to search these Species together.

Applicant is required under 35 USC 121 to elect a single disclosed species to which the claims would be restricted if no generic claim is finally held to be allowable.

6. This application contains claims directed to the following patentably distinct species of the claimed Invention I: wherein the soluble form of B7-H3 comprises one of: SEQ ID NO:10; 12; or 14.

These species are distinct because their structures, physicochemical properties and mode of action are different, and they do not share a common structure that is disclosed to be essential for common utility. Furthermore, the examination of these

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species would require different searches in the scientific literature. As such, it would be burdensome to search these Species together.

Applicant is required under 35 USC 121 to elect a single disclosed species to which the claims would be restricted if no generic claim is finally held to be allowable.

7. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ILIA OUSPENSKI, Ph.D.
Patent Examiner
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November 3, 2006